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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/665,497      | 09/22/2003  | Takashi Shigemura    | 1259-0237P          | 6845             |

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EXAMINER

HAUGLAND, SCOTT J

ART UNIT PAPER NUMBER

3654

DATE MAILED: 04/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/665,497

Applicant(s)

SHIGEMURA, TAKASHI

Examiner

Scott Haugland

Art Unit

3654

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The application as originally files does not disclose that the hardness of the rubber of the roll surface material has a Shore A hardness of 30-70 as recited in claim 1, line 7.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-11 and 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lucas (U.S. Pat. No. 5,553,806) in view of Harkins (U.S. Pat. No. 2,353,462).

Lucas discloses a method of winding a web comprising winding the web into a roll and pressing a rotatable lay-on roll 12, 14, 15 against a peripheral surface of the roll. The lay-on roll includes a surface material formed in a cylindrical shape and including rubber having an effective Shore A hardness of 30-55 or 40-65 (abstract; col. 6, lines 20-26).

Lucas does not disclose that the lay-on roll has a surface material that includes rubber having the claimed volume resistivity.

Harkins teaches providing a material handling roller with an electrically conductive rubber cover having an electrical resistivity of 20,000  $\Omega$  cm (p. 3, col. 1, lines 15-21) to prevent build up of static charge on the roller and handled material.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the lay-on roller of Lucas with a surface material having an electrical resistivity of 20,000  $\Omega$  cm as taught by Harkins to prevent build up of static charge on the roller and the paper web.

Lucas discloses winding a paper web which is seen to be a polymer film as recited in claim 1 since paper comprises polymers. In addition, it would have been obvious to use the winding method of Lucas as modified for winding a continuous polymer film of another type (such as recited in claim 13) and to wind polymer webs having the claimed thicknesses (claims 8, 9) and width (claim 15) since the winder of

Lucas would obviously have been capable of winding a wide range of web materials including ones having these claimed characteristics.

With regard to claim 6, it would have been obvious to use a material with high resistance to ozone to prolong its useful life.

With regard to claims 7, 10, 11, and 16, the selection of winding speed, pressing force, and material length to wind would have been a matter of obvious engineering choice since it would have been well within the level of skill of an ordinary artisan to select the appropriate values of these parameters for the particular web being wound.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lucas in view of Harkins as applied to claims 1, 10, and 11 above, and further in view of Perrigo (U.S. Pat. No. 5, 035,373).

Lucas does not disclose decreasing the pressing force of the lay-on roll on the film roll according to an increase in the radius of the film roll.

Perrigo teaches decreasing the pressing force of a lay-on roll on a web roll with increasing web roll radius (see abstract).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to decrease the pressing force of the lay-on roll of Lucas as the radius of the web roll increases as taught by Perrigo to create a wound roll of the desired hardness. The particular pressing force to apply would have been a matter of obvious engineering choice depending on the material, roll size, width and other factors which are known to those of ordinary skill in the art.

***Response to Arguments***

Applicant's arguments filed 1/26/06 have been fully considered but they are not persuasive.

Applicant argues that the rejection of claims 1-11 and 13-16 based on Lucas '806 and Harkins '462 does not account for the claimed feature of winding continuous polymer film into a form of a film roll. However, as stated in the last Office action and above, Lucas discloses winding paper which is a polymer film.

Applicant argues that Harkins does not account for all of the deficiencies of Lucas and cannot be properly combined with Lucas since Harkins discloses a roll for use in winding textile material and discloses a different roll surface hardness and volume resistivity than is claimed.

However, Harkins discloses a volume resistivity of  $20,000 \Omega \text{ cm}$  which meets the claimed limitations of  $10^2$ - $10^{12} \Omega \text{ cm}$  (claim 1) and  $10^4$ - $10^8 \Omega \text{ cm}$  (claim 4). Harkins discloses a roll cover having a Shore A hardness of 30 to 100 (p. 2, col. 1, lines 25-27) with specific examples of 80 and 85 (below the tables on p. 3, col. 1). The range disclosed by Harkins includes the claimed range and the ranges disclosed by Lucas. An ordinary artisan would have appreciated that the particular hardness of the roll would not significantly affect the electrical properties of the roll and the ability of the roll to prevent build up of electrical charge on the roll. Therefore, the differences in the ranges disclosed by Harkins and Lucas would not have caused an ordinary artisan to discount the teachings of Harkins as they relate to the problem of static electricity build up. Although Harkins relates to handling of textile materials, static build up is known to

occur during handling of other materials including paper and many plastics and it would have been a routine matter for an ordinary artisan to determine if this were occurring during the handling of a particular material. For these reasons, the modification of Lucas to provide the claimed volume resistivity would have been obvious.

In response to Applicant's argument that Harkins is nonanalogous art, it has been held that a prior art reference must either be in the field of Applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Harkins is in the same field as Applicant's invention, i.e., that relating to handling (feeding, winding, etc.) flexible, indeterminate length materials.

Applicant argues that the claimed invention produces unexpected results. However, Applicant has not provided specific evidence of this. The combination of Lucas and Harkins would not produce results that would have been unexpected in view of their teachings and the state of knowledge of the effects of static electricity on handling materials of the claimed type which is indicated by the prior art of record.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

Art Unit: 3654

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Haugland whose telephone number is (571) 272-6945. The examiner can normally be reached on Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kathy Matecki can be reached on (571) 272-6951. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*sjh*  
sjh  
4/5/06

*Kathy Matecki*

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